

06-30-'04 09:52 FROM-Lerner & Greenberg

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T-594 P03/07 U-964

Applic. No.: 09/994,741

Amdt. Dated June 30, 2004

Reply to Office action of March 18, 2004

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-20 remain in the application. Claims 10-20 have been allowed.

In item 2 on page 3 of the above-mentioned Office action, claims 1-4 and 6-7 have been rejected as being anticipated by November (US Pat. No. 2,555,290) under 35 U.S.C. § 102(b).

In item 3 on page 4 of the above-mentioned Office action, claim 5 has been rejected as being unpatentable over November in view of Seaborn et al. (US Pat. No. 4,047,544) under 35 U.S.C. § 103(a).

In item 4 on page 5 of the above-mentioned Office action, claims 8-9 have been rejected as being unpatentable over November in view of Pigna et al. (US Pat. No. 3,854,158) under 35 U.S.C. § 103(a).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and

the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

inserting a binding element into perforations along an edge of a plurality of superposed sheet-like material; and
forming said binding element immediately before said inserting.

The Examiner has stated in the first paragraph on page 7 of the Office action that the term "immediately" is a relative term, which may mean with a few minutes before or possibly a day prior to the formation of the brochure.

Applicants respectfully disagree. It is noted that a term in the claims should be understood in the light of the specification. In paragraph [005] on page 1 of the specification, the disadvantages of the prior art are explained quite clearly. A major disadvantage, among others, is that:

"in order to bind brochures with different formats and thicknesses, the required wire binding elements for the wire binding equipment, in the form of several pre-formed wire binding element supplies, e.g. material wound on spools or elements cut to the binding length, must be

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made available. A considerable number of supplies are needed in order to be able to bind the various brochure formats and thicknesses."

One object of the invention of the instant application is thus to eliminate the binding element supplies. This is achieved by forming the binding element immediately before the inserting, so that only a supply of wire but no supply of pre-formed wire binding elements is necessary. Clearly, in the light of the specification the word "immediately" can only mean that the wire binding element is formed and then used without extensive time or travel in between because that would render the formed wire binding element into a "supply." This should be quite clear to a person skilled in the art.

As already explained in the response to the previous Office action, November states that "[t]he binder in this form is sold by the manufacturer to binders so that the latter can do their binding of books made by them" (see column 2, lines 39-42). Thus, November contemplates forming the "binder" well in advance of insertion into the book.

Clearly, November does not show "forming said binding element immediately before said inserting," as recited in claim 1 of the instant application.

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Claim 1 is, therefore, believed to be patentable over the art and since claims 2-9 are ultimately dependent on claim 1, they are believed to be patentable as well.

Applicants acknowledge the Examiner's statement in item 5 on page 6 of the above-mentioned Office action that claims 10-20 are allowed.

In view of the foregoing, reconsideration and allowance of claims 1-9 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to 37 CFR Sections 1.16 and 1.17 to

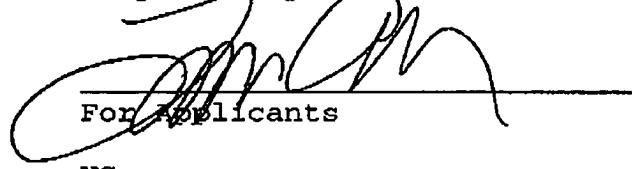
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the Deposit Account of Lerner and Greenberg, P.A., No. 12-
1099.

Respectfully submitted,



For Applicants

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